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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,464	06/14/2001	Stephen O. Friend	100647-3950	1175

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NEW YORK, NY 10022

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/09/2003

41

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/882,464

Applicant(s)

FRIEND ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 23-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-22 is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 12-22 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that all claims are related to the same subject matter so that a search of the prior art when examining the elected claims would at the same time result in a search of non-elected claims. This is not found persuasive because all claims are not related to the same subject matter since claims of Group I are related to a polymeric structure, claims of Group II are related to a process, and therefore a search of the prior art when examining the elected claims would *not* at the same time result in a search of non-elected claims because all groups are classified in different areas. So a search and examining all Groups will put a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 12-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rzepecki et al (US 4,414,260) in view of Nahass et al (US 5,591,382).

As to claims 15, 16, Rzepecki et al disclose a process for making a multilayered static-dissipative polymeric structure for protecting appliances (See column 1, lines 11-16) comprising bonding by lamination (See column 3, lines 15-18) three layers 10-11-12 of differently conductive

polymeric material (See Figs. 1, 2; column 2, lines 25-29) and optionally a base fabric layer 13 (See column 1, lines 63-65); each layer having conductive ingredients such as carbon black so that to achieve the same surface resistance of  $10^8$  ohms per square for layers 10 (a first polymeric layer) and 12 (a third polymeric layer), which is higher than the surface resistance of 300 ohms per square of the intermediate layer 11 (a second polymeric layer) (See column 2, lines 59-68).

Rzepecki et al fail to teach that conductive ingredients are carbon fibrils (Claim 12); the first and said second polymeric layers each comprise from about 0.25% to about 35% by weight of carbon fibrils (Claim 13); or the first polymeric layer comprises from 0.25 to 25% by weight carbon fibrils and said second polymeric layer comprises from 2% to 35% by weight carbon fibrils (Claim 14); the third polymeric layer comprising from about 0.25% to about 35% by weight carbon fibrils (Claim 18).

Nahass et al teach that a conductive, static-dissipative or anti-static polymeric composition having acceptable toughness may be prepared by combining 0.25-50 wt % of carbon fibrils with one or more selected polymeric materials so that the polymeric composition has commercially acceptable conductivity, e.g. volume resistivity of less than about  $10^{11}$  ohm-cm (See column 3, lines 6-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used carbon fibrils in an amount of 0.25-50 wt % as a conductive ingredient for making first, second and third polymeric layers in a process of Rzepecki et al with the expectation of providing the desired toughness and commercially acceptable volume resistivity of less than about  $10^{11}$  ohm-cm, as taught by Nahass et al.

As to claim 17, Rzepecki et al further teach that the multilayered polymeric structure can be used as static-dissipative upholstery material or the like (See column 1, lines 11-13). However,

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Rzepecki et al fail to teach that the multilayered polymeric structure can be formed into a tray or packaging material.

Nahass et al further teach that polymeric materials containing 0.25-50 wt % of carbon fibrils are conductive and have toughness superior to other filled conductive static-dissipative polymeric products (See column 7, lines 30-36) so that they can be used as appliance housing components suitable for electrostatic painting, computer housings capable of EMI shielding, and integrated circuit trays and microelectronics packaging materials suitable for static dissipation (See column 7, lines 47-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a multilayered polymeric structure of Rzepecki et al loaded with 0.25-50 wt % of carbon fibrils for making integrated circuit trays and microelectronics packaging materials suitable for static dissipation since Nahass et al teach that polymeric materials containing 0.25-50 wt % of carbon fibrils are conductive and have toughness superior to other filled conductive static-dissipative polymeric products so that they can be used as appliance housing components suitable for electrostatic painting, computer housings capable of EMI shielding, and integrated circuit trays and microelectronics packaging materials suitable for static dissipation.

***Allowable Subject Matter***

4. **Claims 19-22** are allowed.

The following is an examiner's statement of reasons for allowance: claim 19 is allowed because the prior art of the record does not teach or suggest a process for making a bilayered polymeric structure for packaging of electronic components from molten compositions comprising

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carbon fibrils. Closest prior art of Rzepecki et al teaches a three-layered polymeric structure made from liquid-mixed polymeric-coat ingredients (See column 3, lines 12-25).

Claims 20-22 are allowed as further limiting allowed claim 19.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy  
Examiner  
Art Unit 1762

June 5, 2003



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